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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,233	04/05/2001	Cary Lee Bates	RSW920010047US1	7213

7590

10/19/2005

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EXAMINER

PWU, JEFFREY C

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,233

Applicant(s)

BATES ET AL.

Examiner

Jeffrey C. Pwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3 and 17-20 are rejected under 35 U.S.C. 102(e) as being unpatentable over GUPTA et al. (US 2001/0042,098), Hereinafter GUPTA.

GUPTA teaches claims:

1. A method for providing email that enables a recipient of the email to navigate readily through a set of web pages associated with the email, comprising the acts of:
composing an email to be sent from an originator to a recipient; (paragraph [0011])
In response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators (Annotations) and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient; (method steps 402-408)
associating the navigation with the email; (Annotation Data in Email Message) and
sending the email and the navigation to the recipient. (paragraph [0011]-[0016])
2. A method for guiding a recipient of an email readily through a set of web pages associated with the email, comprising the acts of:

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receiving an email; (302; 352)

receiving a web page navigation associated with the email; (306,308)

passing the web page navigation to a web browser; and (356)

displaying by the web browser a preferred viewing order in which web pages identified

by the web page navigation are to be viewed; (paragraph [0013])

wherein the preferred viewing order is included in the navigation. (in a viewing order

from top to bottom, see fig.8)

3. A method for providing email that guides a recipient readily through a set of associated web pages, comprising the acts of: composing an email to be sent from an originator to a recipient; in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order; sending the email and the web page navigation to the recipient; passing the web page navigation to a web browser used by the recipient; and displaying by the web browser an indication of the preferred viewing order. (Claim 3 is similarly rejected as in claims 1-2)

17. wherein the preferred viewing order is specified by the originator and the email sent to the recipient contains the plurality of URL and the preferred viewing order; [0074]-[0088]

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18. wherein an email program of the originator and a web browser of the originator together generate the web page navigation; [0074]-[0088]

19. wherein the web page navigation is incorporated into the email sent to the recipient; [0074]-[0088]

20. receiving the email and web page navigation with an wmail program of the recipient; passing the web page navigation to a web browser of the recipient ;and displaying an indication of the preferred order with the web browser of the recipient. [0074]-[0088]

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over GUPTA et al. in view of Komuro (US 2002/0186239).

GUPTA teach the invention substantially as claimed including:

composing an email to be sent from an originator to a recipient (paragraph [0011]);

in response to input of the originator generating a navigation that includes:

a plurality of uniform resource locators (306, 308) that identify web pages to be viewed by the recipient;

sending the email and the navigation to the recipient (method steps 402-408);
GUPTA fails to teach having a color associated with each of the URLs according to a color code to indicate a preferred viewing order in which the web pages are to be viewed by the recipient.

Komuro, however, discloses a system for indicating the degree of importance of a link by changing the color to thereby direct users attention to those links first, thereby indicating that those links should be viewed first, i.e. because they are most important, thus indicating a preferred viewing order (Komuro – fig.2; paragraph [0035], [0039] and [0052])

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the link color indication, as taught by Komuro into the invention of GUPTA, in order to provide a visible mark to show the degree of importance of a link (Kimuro – page 1 paragraph [0009]), thus providing a form of a choice viewing order as users should view those links with greatest importance first.

Response to Arguments

5. Applicant's arguments filed 7/21/2005 have been fully considered but they are not persuasive.

With respect to applicant's argument that Gupta does not teach "the sent email

includes a preferred viewing order". In response to applicant's argument that the references fail to show "a preferred viewing order". Firstly, applicant never defined any viewing order in the claim, the examiner therefore interprets the claim as any viewing order or any randomly viewing list. In contrary, Gupta teaches "A method for providing email that enables a recipient of the email to navigate readily through a set of web pages associated with the email, comprising the acts of: composing an email to be sent from an originator to a recipient; (paragraph [0011]) in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators (Annotations) and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient; "Entries into email field 266 can be made on an individual or a "group" basis. Individual email addresses can be entered directly by the user, or can be selected from a pre-defined list." And method steps 402-408) associating the navigation with the email; (Annotation Data in Email Message) and sending the email and the navigation to the recipient. (paragraph [0011]-[0016]) Gupta further teaches a preferred viewing order that shows list of available email addresses can be made available in any of a variety of conventional manners, such as via a pull-down or drop-down menu, a menu bar option, etc. A pre-defined list of email addresses can be obtained from a variety of different sources. For example, email agent 154 of FIG. 3 may have an "address book" or similar listing of email addresses programmed in by the user or other individuals a list of uniform resource locator (URL) annotation from the Dialog box 260.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey C. Pwu whose telephone number is 571-272-6798. The examiner can normally be reached on 7:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



10/14/05

JEFFREY PWU
PRIMARY EXAMINER